



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,106	09/27/2004	Gordon Smith Baxter	000131-00019	1291

2779 7590 07/11/2006

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

MORRISON, JAY A

ART UNIT PAPER NUMBER

2168

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,106

Applicant(s)

BAXTER ET AL.

Examiner

Jay A. Morrison

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21,23-28 are pending.

Claim Objections

2. Claims 1-2,18 are objected to because of the following informalities:
 - a. As per claim 1, line 9: "the information 15 databases" should be "the information databases".
 - b. As per claim 2, line 3: "the 20 information databases" should be "the information databases".
 - c. As per claim 18, line 3: "the 30 repository" should be "the repository".Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show any textual description of elements as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be

removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1,11,15-16,18,23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the corresponding records" in line 9. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "corresponding records".

Claim 11 recites the limitation "the corresponding meta-data" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the associated meta-data".

Claim 11 recites the limitation " the one or more fields" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the corresponding records".

Claim 11 recites the limitation " the information database(s)" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the one or more information databases".

Claim 11 recites the limitation "it" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the corresponding meta-data".

Claim 15 recites the limitation "the group" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the selected group".

Claim 16 recites the limitation "the context" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "a context".

Claim 16 recites the limitation " any repository records located" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "any repository records identified".

Claim 18 recites the limitation " the other terms" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the terms".

Claim 18 recites the limitation "the group" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the selected group".

Claim 18 recites the limitation "the same record" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "the corresponding record".

Claim 23 recites the limitation "the corresponding records" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the office will assume Applicant meant "corresponding records".

Note: the art rejections are made given the best understanding of the Office given Applicants Claims, which are difficult to interpret because of the abundance of assumptions the Office had to make due to their drafting.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20,23-28 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and

Art Unit: 2168

tangible result. To perform a physical transformation, the claimed invention must transform an article or physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce the same results given the same initial starting conditions. To be tangible the claimed invention must produce a practical application or real world result. In this case the claims fail to perform a physical transformation because the claims are directed to operating on data. The claims are useful and concrete, but they fail to produce a tangible result because they are not recorded on a tangible medium nor do they produce any concrete tangible result.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-21,23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cappi (Publication Number 2002/0038308) in view of Chappell ('Understanding .NET: A Tutorial and Analysis', ISBN: 0201741628).

As per claim 1, Cappi teaches

A method of searching a plurality of information databases for records related to an input search term, comprising: (see abstract and background)

selecting a group of related search terms containing the input search term, from a search database of terms arranged in predefined groups according to their relationship with one another, wherein each term is present within one or more of the information databases; (paragraph [0072])

Cappi does not explicitly indicate "and, searching for terms from the selected group within a data repository comprising selected data previously extracted from the records of each information database, to identify the corresponding records within the information 15 databases which contain the terms within the selected group."

However, Chappell discloses "and, searching for terms from the selected group within a data repository comprising selected data previously extracted from the records

Art Unit: 2168

of each information database, to identify the corresponding records within the information 15 databases which contain the terms within the selected group" (page 248, SelectCommand bulletpoint; page 249, figure 6-4).

It would have been obvious to one of ordinary skill in the art to combine Cappi and Chappell because using the steps of "and, searching for terms from the selected group within a data repository comprising selected data previously extracted from the records of each information database, to identify the corresponding records within the information 15 databases which contain the terms within the selected group" would have given those skilled in the art the tools to improve the invention by allowing the user to select information of interest. This gives the user the advantage of not have to examine extraneous information.

As per claim 2,

Cappi does not explicitly indicate "the data repository is arranged as a number of records, each record corresponding to a record present within one of the information databases."

However, Chappell discloses "each record in the repository comprises a pointer identifying the record in the information database to which it relates" (page 249, first paragraph; figure 6-4).

It would have been obvious to one of ordinary skill in the art to combine Cappi and Chappell because using the steps of "each record in the repository comprises a pointer identifying the record in the information database to which it relates" would have

Art Unit: 2168

given those skilled in the art the tools to improve the invention by allowing the user to select information of interest. This gives the user the advantage of not have to examine extraneous information.

As per claim 3,

Cappi does not explicitly indicate “each record in the repository comprises a pointer identifying the record in the information database to which it relates.”

However, Chappell discloses “each record in the repository comprises a pointer identifying the record in the information database to which it relates” (page 248, UpdateCommand bullet point).

It would have been obvious to one of ordinary skill in the art to combine Cappi and Chappell because using the steps of “each record in the repository comprises a pointer identifying the record in the information database to which it relates” would have given those skilled in the art the tools to improve the invention by allowing the user to select information of interest. This gives the user the advantage of not have to examine extraneous information.

As per claim 4,

Cappi does not explicitly indicate “the amount of selected data in the repository is less than that contained in the information databases.”

However, Chappell discloses “the amount of selected data in the repository is less than that contained in the information databases” (page 248, SelectCommand bullet point).

It would have been obvious to one of ordinary skill in the art to combine Cappi and Chappell because using the steps of “the amount of selected data in the repository is less than that contained in the information databases” would have given those skilled in the art the tools to improve the invention by allowing the user to select information of interest. This gives the user the advantage of not have to examine extraneous information.

As per claim 5, Cappi teaches

“the data in the repository comprises definitional data” (paragraph [0010]).

As per claim 6, Cappi teaches

“the definitional data describe data in terms of its nature, use or value”
(paragraph [0010])

As per claim 7, Cappi teaches

“the data in the repository comprises semantic data” (paragraph [0010]).

As per claim 8, Cappi teaches

“the semantic data describes alternative terms for the data in the information database” (paragraph [0010])

As per claim 9, Cappi teaches

Cappi does not expressly show “the semantic data describe synonymous terms in the information databases” (paragraph [0010])

As per claim 10, Cappi teaches

each term in each predefined group within the search database has associated meta-data indicating the one or more information databases within which the term is contained. (paragraph [0010])

As per claim 11, Cappi teaches

the corresponding meta-data indicates the one or more fields of the information database(s) within which it is contained. (paragraph [0010])

As per claim 12, Cappi teaches

a number of records within the data repository are assigned to a domain.
(paragraph [0078])

As per claim 13, Cappi teaches

the terms in the predefined groups within the search database are synonymous terms. (paragraph [0010])

As per claim 14, Cappi teaches
each group has an associated group identifier. (paragraph [0069])

As per claim 15, Cappi teaches
each group has associated descriptive data for describing the group. (paragraph [0067])

As per claim 16, Cappi teaches
determining the context of any repository records located. (paragraph [0078])

As per claim 17, Cappi teaches
the context is determined by limiting the search to repository records having a common domain. (paragraph [0078])

As per claim 18, Cappi teaches
the context is determined by searching for the presence of one or more of the other terms within the group, in the same record of the 30 repository. (paragraph [0078])

As per claim 19, Cappi teaches

the context is determined by searching in related classes of terms. (paragraph [0069])

As per claim 20, Cappi teaches
the context is determined by the proximity of one or more related terms within a record. (paragraph [0010])

As per claim 21, Cappi teaches
A computer program product comprising: a computer readable medium; and
computer program code means on the computer readable medium adapted to perform
the method according to claim 1. (see abstract and background)

As per claim 23, Cappi teaches
A database searching system for searching a plurality of information databases
for records related to an inputted search term, the system comprising: (see abstract and
background)

a search database comprising related search terms arranged into predefined
groups according to their relationship to one another, wherein each term is present
within one or more of the information databases; (paragraph [0069])

selection means, for selecting a group containing the inputted search term from
the search database; (paragraph [0072])

Cappi does not explicitly indicate “a data repository comprising selected data previously extracted from the records of each information database; and, searching means for searching the repository for terms from the selected group to identify the corresponding records within the information databases which contain the terms within the selected group.”

However, Chappell discloses “a data repository comprising selected data previously extracted from the records of each information database; and, searching means for searching the repository for terms from the selected group to identify the corresponding records within the information databases which contain the terms within the selected group” (page 248, SelectCommand bulletpoint; page 249, figure 6-4).

It would have been obvious to one of ordinary skill in the art to combine Cappi and Chappell because using the steps of “a data repository comprising selected data previously extracted from the records of each information database; and, searching means for searching the repository for terms from the selected group to identify the corresponding records within the information databases which contain the terms within the selected group” would have given those skilled in the art the tools to improve the invention by allowing the user to select information of interest. This gives the user the advantage of not have to examine extraneous information.

As per claim 24, Cappi teaches
further comprising an input means for supplying the inputted search term to the selection means. (paragraph [0035]; figure 1, item 102)

As per claim 25, Cappi teaches
the input means comprises a communication network such that the inputted
search term is received from a remote location. (paragraph 0035]; figure 1, item 102)

As per claim 26, Cappi teaches
a plurality of information databases from which data is extracted for storage
within the data repository. (paragraph [0038])

As per claim 27, Cappi teaches
the data repository, is stored upon a separate computer system with respect to
the information databases. (paragraph [0036])

As per claim 28, Cappi teaches
each group has associated descriptive data for describing the group. (paragraph
[0010])

Conclusion

The prior art made of record, listed on form PTO-892, and not relied upon is
considered pertinent to applicant's disclosure.

Art Unit: 2168

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jay Morrison
TC2100

A handwritten signature in black ink, appearing to be 'Debbie Le', written over a horizontal line.

Debbie Le
TC2100

7/6/06